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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,321	10/09/2003	Tobie D. Hatfield	005127.00234	3379

22909 7590 06/16/2005

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/681,321	Applicant(s) HATFIELD ET AL.	
	Examiner Ted Kavanaugh	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) 77-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-25, 27-87, 89-95, 97, 98 and 101 is/are rejected.
- 7) ☒ Claim(s) 17, 26, 88, 96, 99 and 100 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-22-05 & 3-8-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 77-81 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 11, 2005.

Claim Objections

2. Claims 9 are objected to because of the following informalities: In claim 9, "the connecting portion" lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 8,12,31,37,38,52,56,57 and 71 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 8,12,31,37,38,52,56,57 and 71 applicant refers to a "female version" and a "male version" of the footwear which is unclear and indefinite since it is not clear what structure is limited to a female version of footwear and what is limited to a male version of footwear. Therefore the scope of the claims cannot be determined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3728

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4,15 and 89-94 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2188168 (Winkel).

Winkel teaches an article of footwear comprising an exterior layer (30) having a plurality of incisions (36) , and an interior layer (32), the incisions (36) have a first portion (see figure 1) oriented (medial side of footwear) perpendicular to the second portion (lateral side of footwear). The incisions are angled with respect to the longitudinal axis of the shoe and therefore are oriented longitudinally and laterally.

Regarding claims 15 and 94, the footwear upper of Winkel includes a plurality of single layer of material in the heel region.

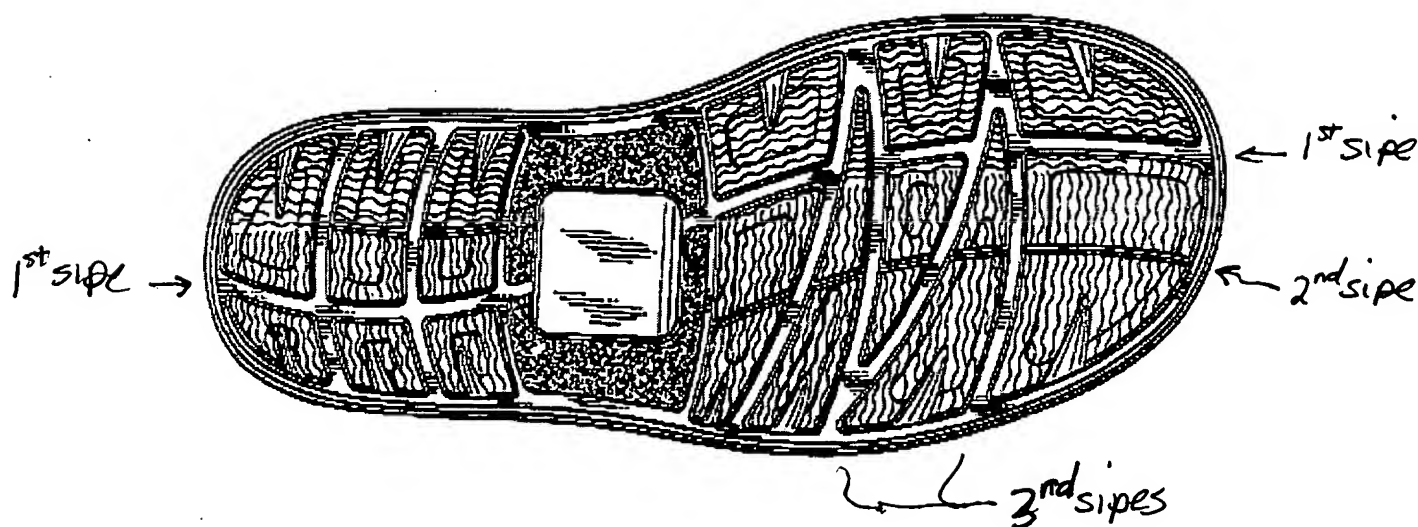
6. Claims 1-2,4,15,16 and 89-91,93-95 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4265032 (Levine).

Levine teaches an article of footwear (see figure 4) comprising an exterior layer having a plurality of incisions (106,114) , and an interior layer (110), the incisions have a first portion (106) and second portion (114) oriented perpendicular to the first portion.

Regarding claims 15,16,94 and 95, the footwear upper of Levine includes the interior layer (110) being a single layer of material in the heel region.

7. Claims 63-65 and 67,69 rejected under 35 U.S.C. 102(b) as being anticipated by D 378472 (Bramani).

Bramani shows a footwear having structure as claimed; see figure 2 below.



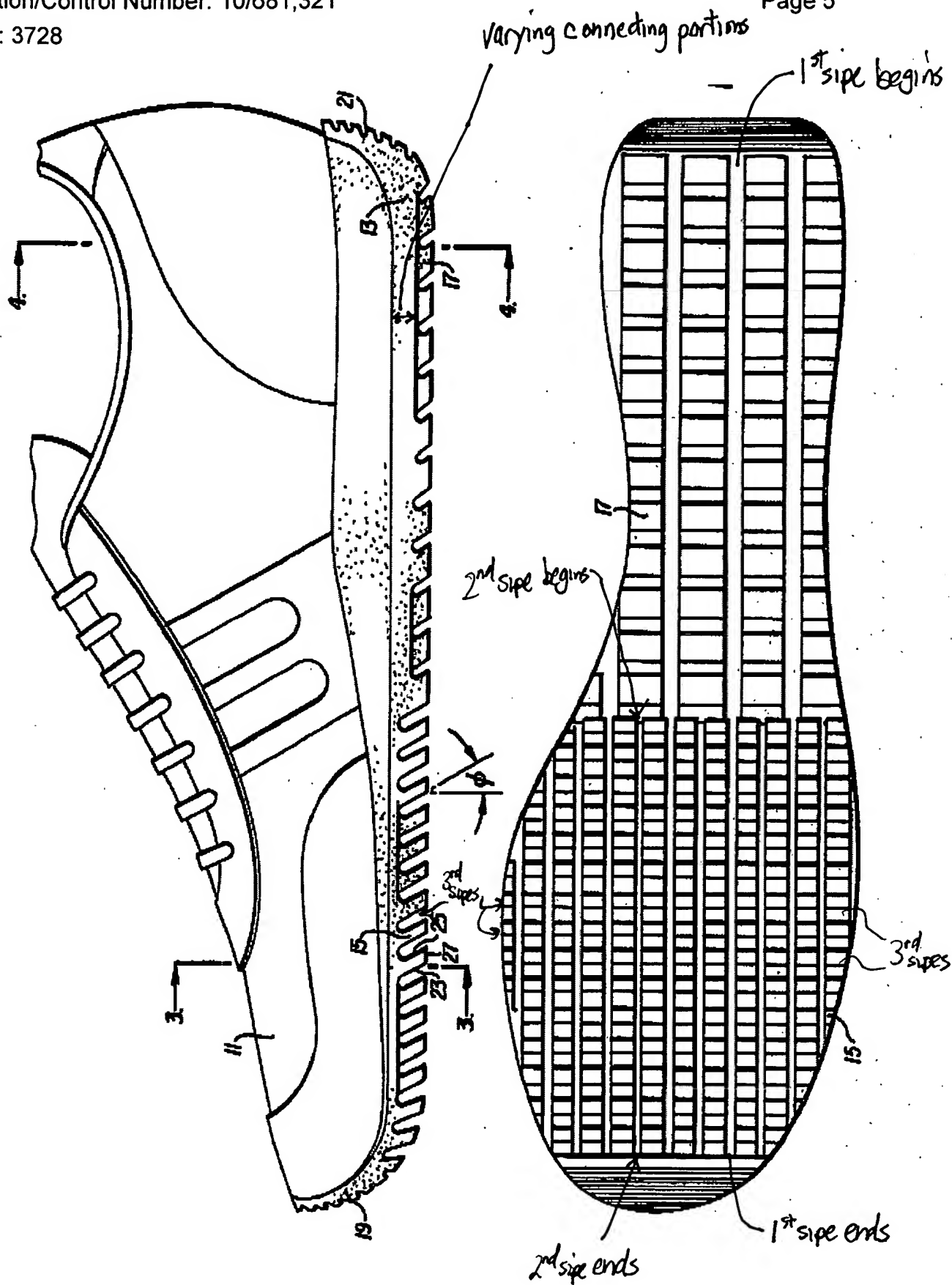
8. Claims 63-64, 67-69, 72 and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4309831 (Pritt).

Pritt teaches an athletic shoe comprising a sole having a plurality of discrete sole elements (cleats) and a plurality of sipes (see figure 2) extending upward into the sole, including a first sipe, a second sipe and a third sipe (see the figure below) substantially as claimed.

Regarding the "connecting portion", the sole as taught above includes a portion (the portion of the same sole) above the cleats to which all of the cleats are attached.

Regarding the first sipe having a curved configuration, see figure 6

Regarding claims 75 and 76, the heel counter (not labeled in figure 1) is a single layer of material having an interior surface and exterior surface of the upper. All layers would have at least an interior and exterior surface.



Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2,4-6,9,11-16,18-25,27-29,32-33,36-40,63,73 and 82-87,89-91,93-95 rejected under 35 U.S.C. 103(a) as being unpatentable over US 4309831 (Pritt) in view of Levine '032.

Pritt teaches an athletic shoe comprising a sole having a plurality of sipes (see figure 2), including a first sipe, a second sipe and a third sipe (see the figure above) substantially as claimed except for the upper having an interior and exterior layer with incisions. Levine teaches an article of footwear (see figure 4) comprising an exterior layer having a plurality of incisions (106,114) , and an interior layer (110), the incisions have a first portion (106) and second portion (114) oriented perpendicular to the first portion. Levine teaches the incisions can be applied to a plurality of different type of footwear so the upper can accommodate various sizes of feet; see col. 3, lines 3-6. It would have been obvious to provide the shoe upper of Pritt with an upper having an interior layer and exterior layer having incisions, as taught by Levine, so the upper can accommodate various sizes of feet.

Regarding the "connecting portion", the sole as taught above includes a portion (the portion of the same sole) above the cleats to which all of the cleats are attached.

Regarding claim 11 and the like (claim 35), the sole as shown in figure 1 of Pritt shows the sole with an overall thickness in the forefoot region being less than the overall thickness in the heel region.

Regarding claim 38 and the like, the difference in overall thickness would appear to be an obvious design choice inasmuch as the desired thickness would be determined by how much cushioning is desired in the particular portions of the shoe sole. The thicker sole would provide increased cushioning.

Regarding claims 13-14 and the like, these claims include product-by-process steps, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). "Product-by-Process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps", MPEP 2113.

11. Claims 63,73,74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritt '831 in view of US 4309831 (Winkel).

Pritt teaches an athletic shoe comprising a sole having a plurality of sipes (see figure 2), including a first sipe, a second sipe and a third sipe (see the figure above) substantially as claimed except for the upper having an interior and exterior layer with incisions. Winkel teaches an upper as such, see the rejection above. It would have been obvious to provide the shoe of Pritt with an upper as taught by Winkel, to better conform to the wearer's foot.

Art Unit: 3728

12. Claims 41-50,53-59,10/5/1 (10 depends from 5/1),34/18,35 rejected under 35 U.S.C. 103(a) as being unpatentable over US 4309831 (Pritt) in view of US 4908964 (Deem).

Pritt teaches an athletic shoe comprising a sole having a plurality of sipes (see figure 2), including a first sipe, a second sipe and a third sipe (see the figure in the rejection above) substantially as claimed except for the connecting portion having the thicknesses as claimed. The connecting portion as claimed reads on most conventional types of contoured midsole as taught by Deem. Deem teaches a contoured midsole 34 (connecting portion) having a first, second and third thickness as claimed (see figures 1-7; specifically the cross-sections shown in figures 2-4). It would have been obvious to provide the shoe of Pritt, with a connecting portion, as taught by Deem, to provide improved arch support.

Regarding claim 57 and the like, the difference in overall thickness would appear to be an obvious design choice inasmuch as the desired thickness would be determined by how much cushioning is desired in the particular portions of the shoe sole. The thicker sole would provide increased cushioning.

Regarding claims 58-59 and the like, these claims include product-by-process steps, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). "Product-by-Process claims are not limited to the manipulations of the recited steps, only the

Art Unit: 3728

structure implied by the steps”, MPEP 2113.

13. Claims 61 and 62 rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 41 above, and further in view of either Levine '032 or Winkel '168.

As described above, both Levine and Winkel teach an upper having an interior layer and an exterior layer with incisions. It would have been obvious to provide the shoe as taught above with an upper, as taught by either Levine or Winkel, so the upper can accommodate various sizes of feet.

14. Claims 97,98 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritt '831 in view of US 2224590 (Boivin)

Pritt as described numerous times above teaches an article of footwear as claimed except for an insole having a plurality of flexion lines. Boivin teaches an insole (shoe filler) with lines of flexion (17) as claimed. It would have been obvious to provide the footwear of Pritt with an insole, as taught by Boivin, to provide better ventilation in the footwear. Regarding the “corresponding with positions”, in view of the numerous lines of flexion and sipes it would only be natural that some would correspond with each other.

15. Claims 7,8;30,31;51,52; and 70,71 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 6;27;48; and 63 above, and further in view of US 4309832 (Hunt).

Hunt teaches a sipe (18) that corresponds to the third sipe above that has a greater width, see figure 1. It would have been obvious to provide the footwear as

Art Unit: 3728

taught above with the third sipe having a greater width, as taught by Hunt, inasmuch as greater flexibility is desired in the ball region of the foot.

16. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 41 above, and further in view of US 6115945 (Ellis).

Ellis teaches the slits having an additional lower outsole element (see the bottom most layer in figures 6,7 and 8. It would have been obvious to provide the footwear as taught above with at least one outsole element secured to the bottom of the sipes, as taught by Ellis, to provide better wear characteristics.

17. Claims 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bramani '472 in view of US 2155166 (Kraft).

Bramani teaches footwear as claimed (see the rejection above) except it is not clear if the depth of the first sipe increases in depth from the forefoot region to the heel region. Kraft teaches the sipe increases in depth in the heel region; see page 1, col. 2, lines 28-34. It would have been obvious to provide the footwear of Bramani with the first sipe increasing in depth, as taught by Kraft, to provide more stability.

Allowable Subject Matter

18. Claim 17,26,88,96 and 99-100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. ***The examiner suggest that the Attorney would limit the number of claims to 20 inasmuch as the examiner is not given any additional time to examine***

Art Unit: 3728

excessive number of claims. Examining 101 claims is an extreme burden on the examiner. This is only a suggestion and not a requirement.

20. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

21. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be


obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (FORMAL FAXES ONLY). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

Application/Control Number: 10/681,321
Art Unit: 3728

Page 12


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
June 13, 2005